

REMARKS

Claims 1-29 are currently pending. The Examiner has finally rejected Claims 1-29 under 35 U.S.C. 102(e) as being anticipated by Hoffert, et al.

Applicants have argued that the Hoffert patent, U. S. Patent 6,374,260 (hereinafter, "the '260 patent"), which was filed on February 28, 2000, might not be an appropriate reference since the filing date of the Continuation-in-Part (CIP) application is later than the filing date (October 9, 1999 based on provisional patent application 60/103,303 filed October 6, 1998) of the present patent application.

While the chain of applications to which the Hoffert CIP refers includes some dates (for U.S. Patent No. 5,903,892, filed April 30, 1997, based on provisional applications filed as early as May 24, 1996) which are earlier than the effective date of the present application, Applicants assert that the earlier applications did not include the relevant teachings on which the Examiner relies for the anticipation rejection.

Specifically, the cited teachings regarding transcoding, which are found in lines 37-41 of Col. 11 of the Hoffert CIP, the '260 patent, are not found in the patent, U. S. Patent No. 5,903,892 (hereinafter, "the '892 patent"), that issued on the

originally-filed Hoffert parent application filed on April 30, 1997.

Applicants refer the Examiner's attention to Col. 20 of the '892 patent, at which are found teachings which parallel some, but not all, of the teachings found in Col. 11 of the later '260 patent. Specifically, section 4.2 entitled "Preview Generation", which is found in the '892 patent from Col. 20, line 1-Col. 20, line 11, includes teachings that parallel those found in section 5.2 entitled "Preview Generation", which is found from Col. 11, line 4-Col. 11, line 14 of the '260 patent. However, the '892 patent does not include any teachings which parallel the transcoding teachings, found from Col. 11, line 15 through Col. 11, line 61 of the '260 patent. Rather, the '892 patent "skips" to section 4.2.1 entitled "Sizing of preview and images" beginning at Col. 20, line 15, which parallels section 5.2.1 entitled "Sizing of preview and images" found starting at Col. 11, line 62 of the '260 patent. Clearly the transcoding teachings, which are found in Col. 11 from line 15 to line 61 of the '260 patent, are not included in the '892 patent.

Applicants respectfully submit that the Examiner has erroneously assumed that the teachings of the CIP, the '260 patent, were part of the parent application, the '892 patent. However, the transcoding teachings of the '260 patent were not included in the parent '892 patent application. Therefore, those teachings are not entitled to the earlier filing date.

Since the cited teachings of the '260 patent were not available as a reference against the present invention, Applicants respectfully request withdrawal of the 102 rejections based on those teachings, and withdrawal of the final status of the Office Action dated October 21, 2002.

Applicants further assert that those Hoffert patent teachings which were available to be asserted against the present invention do not anticipate the invention as claimed. The Hoffert patent teaches a method and apparatus for searching for media content and for delivering for display a predetermined portion (i.e., a preview) of the media content which has been retrieved (see: Col. 10, lines 58 et seq. of the '260 patent and Col. 19, lines 56-63 of the '892 patent). The delivery of the portion of the media content comprises selecting a predetermined portion (i.e., the preview) and displaying that portion.

The Hoffert patent does not, however, analyze the content of a multimedia presentation and perform transcoding based on the analysis, which is expressly recited in pending independent Claim 1, as well as in Claims 2-24 and 29 which depend from Claim 1, in pending independent Claim 25, as well as in Claim 26 which depends from Claim 26, and in pending independent Claim 27, as well as in Claim 28 which depends from Claim 27.

Applicants further note that, with regard to the Examiner's rejection of Claims 2, 3, 6, 7, 16, 23, 24, 26, 27, 28, the Examiner has cited the Col. 11 passage from the Hoffert '260

patent for which parallel teachings are not found in the '892 patent and which is, therefore, not available against the present application. Similarly, with regard to the cited teachings from Col. 2, lines 5-8 and Col. 7, lines 63, et seq., Applicants do not find parallel teachings in the earlier-filed '892 patent.

Applicants had also previously noted that the Examiner erroneously rephrased the claim language in the first Office Action rejection to recite "analyzing the content of the multimedia **representation**". While Hoffert may have a multimedia "**representation**" which comprises the predetermined portion of media content, such is not the same as a whole multimedia presentation. Hoffert does not analyze the multimedia representation (let alone the whole multimedia presentation) for transcoding. Hoffert merely selects the predetermined portion which has been prespecified for or by the user. Finally, Hoffert does not transcode based on analysis of multimedia presentation content. The '892 Hoffert patent simply teaches that the preview is selected and delivered.

It is well established under U.S. Patent Law that, for a reference to anticipate claims under 35 USC § 102, the reference must teach each and every claim feature. Since the Hoffert patent does not teach transcoding based on the analyzing of content of a multimedia presentation, it cannot be maintained that Hoffert anticipates the invention as set forth in independent Claims 1, 25, and 27. Furthermore, Applicants assert

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that a reference which does not anticipate the independent claims cannot be said to anticipate those claims which depend from the independent claims and which add limitations thereto. Therefore, the language of Claims 2-24, 26 and 28-29 is not anticipated by the Hoffert patent.

Based on the foregoing remarks, Applicants request withdrawal of the rejections, withdrawal of the final status of the previous Office Action, refunding of the filing fee for the RCE, and issuance of the claims.

Respectfully submitted,
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